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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,957	12/31/2001	Sithya S. Khieu	53325US002	8431

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EXAMINER

HARTMANN, GARY S

ART UNIT PAPER NUMBER

3671

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,957

Applicant(s)

KHIEU ET AL.

Examiner

Gary Hartmann

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-12 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 20,24-26,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-12,15-19,21-23 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/18/4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 28 and 29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they are related to the originally claimed invention as combination/subcombination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28 and 29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-9, 12, 15, 18, 21, 22 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Eigenmann (U.S. Patent 4,072,403).

Eigenmann discloses a marker and method of making pavement markers including forming an array of discrete retroreflective elements (G, Figure 8, for example) in a predefined pattern interconnected by a carrier web (14'). The elements (G) are bonded to the web (14').

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There is a frangible connection between a plurality of the pavement elements and the carrier web (Figure 7, for example).

The carrier web (14') is bonded to an upper surface of the paving elements (Figure 6, for example).

Regarding claims 6 and 7, see column 2, lines 14-20, for example.

The structure of the web (14') meets the recitation of a release liner.

There are retroreflective lenses (18) on the top and side surfaces.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann, as applied above. Given Eigenmann's disclosure that the web is designed to be severed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used slits around a perimeter of the elements in order to separate the elements.

Regarding claim 23, it is well known to use cube corner retroreflective elements in pavement markers and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have done so with Eigenmann in order to obtain a desired visibility characteristic.

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Claims 5, 10, 11, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann as applied above, and further in view of Clark et al. (U.S. Patent 5,853,846). Eigenmann is silent with respect to an adhesive; however, the markers are designed to be adhered to a roadway and it is well known to use pressure sensitive adhesives to apply markers to roadways. For example, Clark et al. teach a pressure sensitive adhesive (8) with a liner (10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the adhesive of Clark et al. with the marker of Eigenmann in order to obtain a secure connection between the marker and the pavement.

Response to Arguments

Applicant's arguments filed 4/15/2004 have been fully considered but they are not persuasive. Note that the web used in this Office action is 14' rather than 16'. This meets claim recitations, as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a series of fluid, connected strokes that form the name 'Gary Hartmann'.

Gary Hartmann
Primary Examiner
Art Unit 3671

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